

## **REMARKS**

The purpose of this submission is to present claim amendments and arguments in reply to the positions taken by the Examiner in the Office Action dated July 14, 2006.

### **I. Interview Proceedings**

Preliminarily, this opportunity is taken to thank the Examiner for the many courtesies extended to the undersigned in the course of two telephonic interviews conducted on August 8, 2006 and August 17, 2006, respectively. During the interviews pending rejections under 35 U.S.C. §§ 102 and 103 in respect of claims 58-99, as set forth in the Office Action, were substantively discussed. A more detailed recounting of the interview proceedings is interwoven into the treatment of the pending rejections hereinafter.

### **II. Formal Rejection**

The Examiner's notification that the dependency of claim 95 (and, in turn, 96) is incorrectly from cancelled claim 92 (directly or indirectly), coupled with the implication that dependency from claim 89 was presumably intended, is appreciated. In any event, claims 89, 95 and 96 have now been cancelled (see discussion in Section III, *infra*) and thus the rejection is believed obviated.

### **III. Prior Art Rejections**

In the telephonic interviews, consideration of various rejections under 35 U.S.C. §§ 102 and/or 103 was allocated into two basic parts: colorant compositions and methods of making same in claims 58-77; and paint and methods of making same in claims 78-99.

#### **Paints/Related Methods**

Taking the latter first, the Examiner indicated during the interview proceedings that satisfactory basis for allowing the paint and corresponding method claims would be afforded by test evidence establishing a difference between aqueous latex paint made in accordance with the

invention – i.e., by combining a “tint-base” and the precursor colorant composition of the invention – and aqueous latex paint covered by the patents relied upon for the rejections (wherein there is no teaching of combining a tint-base and precursor colorant composition). By way of example, she was understood to agree that showing the paint of the invention, made with a pre-combined colorant and copolymer surfactant in a precursor colorant composition, to have one or more properties (e.g., color transfer, color rub-up, color development or viscosity stability) superior to that of aqueous latex paint made by combining all the paint’s components essentially at once (i.e., without utilizing a precursor colorant composition), inferentially as a consequence of enhanced bonding between the colorant and copolymer surfactant in the precursor vis-à-vis the aqueous latex paint of the patents, would warrant a conclusion that the paint of the invention neither is anticipated by nor would have been obvious from the patents relied upon by the Examiner. (This would be the case because the greater amount of colorant/copolymer surfactant bonding with the invention as opposed to the paints covered in the patents would constitute a physical difference stemming from the difference in the respective processes for making, and further would have led to unexpected property superiority for the paint of the invention; the patents cited in support of the rejections simply are devoid of disclosure that paints should be made utilizing a precursor colorant composition containing a copolymer surfactant per the invention.)

That said, applicants have decided to delete the claims relating to aqueous latex paints and methods for making them, without prejudice, and with the present intention of pursuing claims of such nature in a continuing application. Therefore, it is urged that the rejections of claims 78-99 are obviated and their withdrawal is requested.

**Colorant Composition/Related Methods**

The threshold crux of the patentability issues pertaining to applicants' claimed colorant compositions and methods for making same is whether the claim language excludes the aqueous latex paints taught in the patents cited in support of the § 102/103 rejections, and thus patentably distinguishes the invention from those patent teachings. In the interview proceedings the Examiner considered proposed amended language for main claim 58 directed to the colorant compositions of the invention (which amended claim language and accompanying comments concerning where in the application the amended language finds support were provided to the Examiner by facsimile and are annexed as Exhibit A). The amendments were based on the Examiner's suggestion of the possibility of introducing into claim 58 language explicitly defining the claimed subject matter as excluding aqueous latex paints per the patents upon which the rejections are based. Thus, the claim language is modified in this submission so that the defined colorant composition is prescribed to be "not itself an aqueous latex paint" with the objective of effectively excluding the paints of the aforementioned patents, the language being supported in the application so as to comply with 35 U.S.C. § 112. (Though applicants do not acquiesce, the Examiner had indicated she was not convinced, on the record as it stood prior to the instant response, of the patentability-conferring effect of having inserted into claim 58 the expression "consists essentially of" or a variant, along with other amendments and arguments such as pointing out disclosure in the application of the specialized paint-exclusive meaning of "colorant composition".)

It was understood as the culmination of talks with the Examiner that she agrees the newly proposed wording, namely, "which colorant composition is not itself an aqueous latex paint", clearly excludes the aqueous latex paints taught in the patents in question, and is supported by

the application's disclosure. On the latter point, applicants reiterate the explanation of such support accompanying the suggested new claim language in the facsimile to the Examiner dated August 16, 2006:

Among other places, the language defining colorant compositions which are not aqueous latex paints finds basis in the application's Examples 9-12, especially when contrasted with the embodiments of Examples 13 and 14. More specifically, Examples 9-12 disclose colorant compositions which contain pigment(s), water and various other additives, including copolymer surfactant, etc. – but not a latex component sufficient to constitute the composition of an aqueous latex paint. On the other hand, Example 13 discloses “an acrylic semi-gloss tint-base latex, i.e., a latex base paint or untinted latex.” In Example 14, “aliquots of the untinted base described in Example 13 were tinted with colorant compositions of the invention.” Thus, colorant compositions which are not aqueous latex paints are disclosed separate and apart from untinted aqueous latex paint and from tinted aqueous latex paint. This amply supports the limitation in Claim 58 that the colorant “is not itself an aqueous latex paint.”

Confirming applicants' remarks during the interview proceedings, they now submit that the rejections of claim 58, and the colorant composition claims depending therefrom: (1) under § 102 for anticipation by the aqueous latex paint teachings of the Sonnabend, Hawe et al. and Chang et al. patents are unjustified as the claim language expressly and directly excludes all such paints; and (2) under § 103 based on the Sonnabend, Hawe et al., Chang et al. and Robinson patents are also unjustified as none of those patents teaches a precursor colorant composition of the type defined in claim 58 that exhibits a viscosity stabilization effect, so one of ordinary skill in the art would not have had the requisite motivation to formulate the invention.

Particularly as to the last point in the preceding paragraph, the Examiner has relied in the Office Action, in attempted refutation of the point that the claimed colorant composition is not disclosed in the patents cited as basis for the rejections, “that Hawe et al. explicitly teaches the use of its polymeric thickener in pigment pastes (col. 8, line 51).” But such reliance on Hawe et

al. is misplaced as a closer look at the col. 8 disclosure of that patent demonstrates. More specifically, and as emphasized during the telephonic interview proceedings, it is evident from the passage in question that it relates not to pastes which are precursor colorant compositions for making aqueous latex paint, but rather to “textile printing pastes.”

Pursuant to the Examiner’s request in the interview proceedings, applicants take this opportunity to explain why textile printing paste technology would have been seen as inapplicable to consideration of their invention. The undersigned is advised that textile printing pastes are not intrinsically water-based, are often of impractically high viscosity for aqueous latex paint formation, are typically deficient in pigment content for such paint formation, and are commonly seen as an anti-viscosity-build-up agent rather than a viscosity-decrease-preventative (which is an important aspect of viscosity stabilization, as the viscosity must be kept from increasing or decreasing too much). These differences are reflected in the Hawe et al. patent. For instance, Example 8 evidences that the subject textile printing paste does not have to be water-based, as the subject paste contains kerosene, and is solvent-based. Further, while the printing paste of Example 9 is water-based it has much higher viscosity (19,600+) than that which is advantageous for the colorant composition of applicant’s invention (for example, 1,000-2,500) in order for the composition to be suitable for discharge from a colorant dispenser into a tint-base (typically, at a retail outlet, as explained on page 15 of the “Submission Including Amendments under 37 CFR 1.114” filed May 2, 2006). Moreover, there is only 4% colorant in the Example 9 paste, which would be much too low for a colorant composition that is used for making an aqueous latex paint. The printing paste of Example 10 is similar. Perhaps most striking, is the revelation in col. 9, lines 9-15, of the patent that with the described technology viscosity build-up is “greatly reduced”. This intuitively runs counter to the viscosity stabilization

feature of applicants' claimed invention, which (in addition to mitigating viscosity increase) must have the capability of mitigating the decrease in viscosity normally expected when a colorant composition is added to and dilutes a tint base. Thus, it is believed one of ordinary skill in the art would not have drawn on the printing paste teachings in the Hawe et al. patent for insight regarding a colorant composition suitable for making an aqueous latex paint.

Likewise, for essentially the same reasons as the colorant composition claims, the corresponding method of making claims would also seem allowable. In short, nothing in the patents cited as support for the § 102 and § 103 rejections of the method claims either constitutes a single-source disclosure of applicants' method invention or would have motivated one to develop the steps of applicants' method leading to production of applicants' colorant composition, especially in light of the latter's itself being novel and nonobvious.

Accordingly, reconsideration and withdrawal of the § 102 and § 103 rejections of claims 58-77 are requested.

#### **Copolymer Surfactants**

While claims 100 and 101 directed to copolymer surfactants which are useful in the colorant compositions of claims 58 to 77 were not materially considered during the telephonic interview proceedings, applicants reserve the right to prosecute their subject matter further. To advance prosecution, applicants are cancelling claims 100 and 101 from the instant application, without prejudice, and with the present intention of pursuing claims of such nature in a continuing application. Therefore, it is urged that the rejections of claims 100 and 101 are obviated and their withdrawal is requested.

**Other References**

Supplementing the identification of U.S. Patent No. 6,887,928 in the Information Disclosure Statement filed May 2, 2006, applicants take this opportunity to bring Rohm and Haas U.S. Appln. Serial No. 10/407,959 to the Examiner's attention. The application is a Continuation-in-Part of the above-mentioned patent.

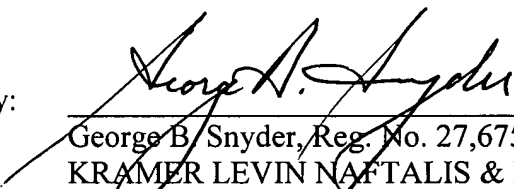
**Conclusion**

In view of the foregoing amendments and remarks, allowance of the application with claims 58-77 is solicited.

Respectfully submitted,

Dated: September 29, 2006

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